



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,373	12/12/2001	Eric Rosen	010558	2149

23696 7590 10/04/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

BHATTACHARYA, SAM

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,373

Applicant(s)

ROSEN ET AL.

Examiner

Sam Bhattacharya

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-40 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16,18-20,41,43-46,48-51,53-56 and 58-60 is/are rejected.
- 7) ☒ Claim(s) 2,7,12,17,42,47,52 and 57 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 19, 41, 43, 44, 46, 48, 49, 51, 53, 54, 56, 58 and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US 6,741,580 B1).

Regarding claims 1, 6, 11 and 16, Kim et al. disclose a base apparatus for delivering information to a mobile station in a group communication network, inherently including a receiver to receive information over the network, a transmitter to transmit information over the network, and a processor communicatively coupled with the receiver and the transmitter, wherein the processor determines whether the information is smaller than a predetermined size limit, and delivers the information to the mobile station on a forward common channel if the

Art Unit: 2685

information is smaller than the predetermined size limit. See FIG. 5 and col. 2, line 66 – col. 3, line 3.

Regarding claims 3, 8, 13 and 18, Kim et al. disclose delivering the information on a forward paging channel (F-PCH). See col. 4, line 66.

Regarding claims 4, 9, 14 and 19, Kim et al. disclose delivering the information on a forward common control channel (F-CCCH). See col. 4, line 67.

Regarding claims 41, 46, 51 and 56, Kim et al. disclose that the information is tagged or identified for delivery to the mobile since the delivery is based on the information being smaller than a predetermined size.

Claims 43, 48, 53 and 58 depend from claims 41, 46, 51 and 56, and incorporate the limitations of claim 3, and are therefore rejected for the same reasons as these claims.

Claims 44, 49, 54 and 59 depend from claims 41, 46, 51 and 56, and incorporate the limitations of claim 4, and are therefore rejected for the same reasons as these claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 2685

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 5, 10, 15, 20, 45, 50, 55 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Sayeedi (US Patent Application Publication No. 2002/0145990 A1).

Regarding claims 5, 10, 15 and 20, Kim et al. fail to disclose delivering the information on the common channel in short data burst form.

Sayeedi discloses delivering information from a base station to a mobile station on a common control channel in short data burst form. See claim 2, lines 4-7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the delivering step in Kim et al. by using a short data burst on the common control channel as taught by Sayeedi so that a minimal amount of bandwidth is used on the channel and traffic channels are not used up unnecessarily.

Claims 45, 50, 55 and 60 depend from claims 41, 46, 51 and 56, and incorporate the limitations of claim 5, and are therefore rejected for the same reasons as these claims.

Allowable Subject Matter

1. Claims 2, 7, 12, 17, 42, 47, 52 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2685

2. Claims 21-40 are allowed.

3. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to disclose that delivering information to a mobile station on a forward control channel includes delivering the information when the mobile station is in idle state with no traffic channel, as in claims 2, 7, 12, 17, 42, 47, 52 and 57; the prior art of record fails to disclose a server that extracts encapsulated information from a frame and delivers the information to a mobile station on a forward common channel, as in claims 21, 26, 31 and 36.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malcolm et al. (US 5,790,939) disclose a gateway that calculates a frame timing offset and transmits the offset to a mobile terminal.

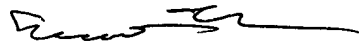
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (703) 605-1171. The examiner can normally be reached on 8:30 a.m. to 5:00 p.m., Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sb


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600